

GP-3635

Practitioner's Docket No. SST/816

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Commins, Leek, Linn, Gregg, Colonias/Simpson Stradling, Inc.  
Application No.: 08 / 975,940 Group No.: 3635  
Filed: November 21, 1997 Examiner: Kent, C.  
For: BUILDING WALL FOR RESISTING LATERAL FORCES



Assistant Commissioner for Patents  
Washington, D.C. 20231

11-02-99

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Date of Deposit October 20, 1999

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Charles R. Cypher

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Charles R. Cypher

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Practitioner's Docket No. SST/816

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Commins, Leek, Gregg, Colonias/Simpson Strong-Tie Co., Inc. & Linn

Application No: 0 8 /975,940 Group No.: 3635

Filed: November 21, 1997 Examiner: Kent, C.

For: BUILDING WALL FOR RESISTING LATERAL FORCES



Assistant Commissioner for Patents  
Washington, D.C. 20231

**TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT  
BEFORE MAILING DATE OF EITHER A FINAL ACTION  
OR NOTICE OF ALLOWANCE (37 C.F.R. § 1.97(c))**

**NOTE:** An information disclosure statement shall be considered by the Office if filed . . . before the mailing date of either (1) a final action under § 1.113 or (2) a notice of allowance under § 1.311, whichever occurs first, provided the statement is accompanied by either a statement as specified in paragraph (e) of section 1.97 or the fee set forth in § 1.17(p).

**NOTE:** "If a final action or notice of allowance is mailed in an application and later withdrawn, the application will be considered as not having had a final action or notice of allowance mailed for purposes of considering an information disclosure statement." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

**NOTE:** "If information submitted during the period set forth in 37 C.F.R. 1.97(c) with a certification is used in a new ground of rejection on unamended claims, the next Office action will not be made final since in this situation it is clear that applicant has submitted the information to the office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office. However, the information submitted with a certification can be used in a new ground of rejection and the next Office action made final, [i]f the new ground of rejection was necessitated by amendment of the application by applicant. Where the information is submitted during this period with a fee, the examiner may use the information submitted, e.g., printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP 706.07(a). If a new ground of rejection is introduced that is neither necessitated by an amendment to the claims nor based on the information submitted with the fee set forth in 37 C.F.R. § 1.17(p), the Office action shall not be made final." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

**CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))**

I hereby certify that this correspondence is, on the date shown below, being:

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EM # EL440266166US

Date: October 20, 1999

**FACSIMILE**

transmitted by facsimile to the Patent and Trademark Office.

Signature

Charles R. Cypher

(type or print name of person certifying)



## TIME OF TRANSMITTAL OF ACCOMPANYING INFORMATION DISCLOSURE STATEMENT

1. The information disclosure statement transmitted herewith is being filed **after** three months of the filing date of this national application or the date of entry of the national stage as set forth in § 1.491 in an international application or after the mailing date of the first Office action on the merits, whichever event occurred last but **before** the mailing date of either:
  - (1) a final action under § 1.113 or
  - (2) a notice of allowance under § 1.311,whichever occurs first.

### STATEMENT OR FEE

2. Accompanying this transmittal is

(check either A or B below)

- a statement as specified in 37 C.F.R. § 1.97(e).

OR

- the fee set forth in 37 C.F.R. § 1.17(p) for submission of an information disclosure statement under § 1.97(c). (\$240.00).

### FEE PAYMENT

(complete this item, if applicable)

3. Applicant elects the option to pay the fee set forth in 37 C.F.R. § 1.17(p) for submission of an information disclosure statement under § 1.97(c) (\$240.00).

Fee due \$ 240.00

### METHOD OF PAYMENT OF FEE

4.

Attached is a check in the amount of \$ 240.00 ck. no. 5090  
 Charge Account No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_.  
A duplicate of this request is attached.

If any additional fees are due, please charge Account 03-4075

(Transmittal of Information Disclosure Statement before Mailing Date of Either a Final Action Or Notice of Allowance [6-4]—page 2 of 3)

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Charles R. Cypher

**SIGNATURE OF PRACTITIONER**

Charles R. Cypher

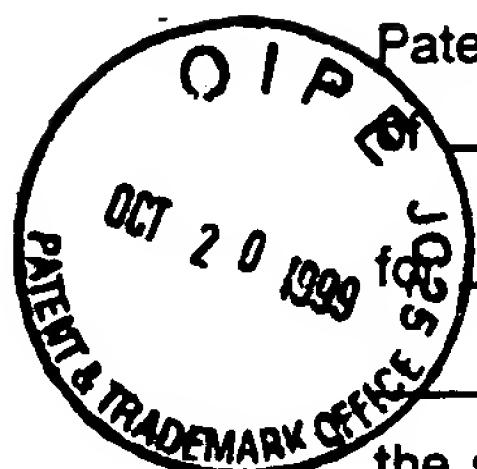
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405 - 14th Street, Suite 1607

**P.O. Address**

Oakland, CA 94612-2747

(Transmittal of Information Disclosure Statement before Mailing Date of Either a Final Action Or Notice of  
Allowance [6-4]—page 3 of 3)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Patent application

Inventor(s)

Title of invention

the specification of which is being transmitted herewith

OR

In re application of: Commins, Leek, Linn, Colonias, Gregg/Simpson Strong-Tie Co., Inc.  
Application No.: 08 /975,940 Group No.: 3635  
Filed: November 21, 1997 Examiner: Kent, C.  
For: BUILDING WALL FOR RESISTING LATERAL FORCES

**Assistant Commissioner for Patents**  
Washington, D.C. 20231

**INFORMATION DISCLOSURE STATEMENT****CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\***

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I hereby certify that, on the date shown below, this correspondence is being:

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Charles R. Cypher  
Signature

Date: October 20, 1999Charles R. Cypher

(type or print name of person certifying)

**\*WARNING:** Each paper or fee filed by Express Mail **must** have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. § 1.10(b).

"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will **not** be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

OK

NOTE: "An information disclosure statement shall be considered by the Office if filed by the applicant:

- (1) Within three months of the filing date of a national application;
- (2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; or
- (3) Before the mailing date of a first Office action on the merits, whichever event occurs last."

37 C.F.R. § 1.97(b).

NOTE: "Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section." 37 C.F.R. § 1.56(a).

"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) each inventor named in the application;
- (2) each attorney or agent who prepares or prosecutes the application; and
- (3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. § 1.56(c).

NOTE: The "duty as described in § 1.56 will be met so long as the information in question was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98 before issuance of the patent." Notice of January 9, 1992, 1135 O.G. 13 -25 at 17.

WARNING: "No information disclosure statement may be filed in a provisional application." 37 C.F.R. § 1.51(b).

### **List of Sections Forming Part of This Information Disclosure Statement**

The following sections are being submitted for this Information Disclosure Statement:

*(check sections forming a part of this statement: discard unused sections and number pages consecutively)*

1.  Preliminary Statements
2.  FORMS PTO/SB/08A and 08B (formerly FORM PTO-1449)
3.  Statement as to Information Not Found in Patents or Publications
4.  Identification of Prior Application in Which Listed Information Was Already Cited and for Which No Copies Are Submitted or Need Be Submitted
5.  Cumulative Patents or Publications
6.  Copies of Listed Information Items Accompanying This Statement
7.  Concise Explanation of Non-English Language Listed Information Items
  - 7A.  EPO Search Report
  - 7B.  English Language Version of EPO Search Report
8.  Translation(s) of Non-English Language Documents
9.  Concise Explanation of English Language Listed Information Items (Optional)
10.  Identification of Person(s) Making This Information Disclosure Statement

*(complete the following, if appropriate)*

Sections \_\_\_\_\_, respectively, have been continued on ADDED PAGE(S).

NOTE: "Once the minimum requirements are met, the examiner has an obligation to consider the information." Notice of April 20, 1992 (1138 O.G. 37-41, 37).

## **Section 1. Preliminary statements**

Applicants submit herewith patents, publications or other information, of which they are aware that they believe may be material to the examination of this application, and in respect of which, there may be a duty to disclose.

The filing of this information disclosure statement shall not be construed as a representation that a search has been made (37 C.F.R. 1.97(g)), an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists.

The filing of this information disclosure statement shall not be construed as an admission against interest in any manner. Notice of January 9, 1992, 1135 O.G. 13-25, at 25.

## Section 2. Forms PTO/SB/08A and 08B (formerly Form PTO-1449)

NOTE: With respect to the list required by paragraph (b) of 37 C.F.R. 1.98, the Notice of April 20, 1992 (1138 O.G. 37-41) points out that:

"The list may not be incorporated into the specification but must be submitted in a separate paper. A separate list is required so that it is easy to confirm that applicant intends to submit an information disclosure statement, and because it provides a readily available checklist for the examiner to indicate which identified documents have been considered. A copy of a separate list will also provide a simple means of communication to applicant to indicate the listed documents that have been considered and those listed documents that have not been considered. Use of form PTO-1449, "Information Disclosure Citation, is encouraged."

NOTE: "An information disclosure statement may include two list[s (and two certifications)] . . . in situations where some of the information listed was cited in a communication from a foreign patent office not more than three months prior to filing the statement and some was not, but was not known more than three months prior to filing the statement." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

NOTE: With respect to the examiner's consideration of the Information Disclosure Statement, the Notice of April 20, 1992 (1138 O.G. 37-41) states:

"If information is listed in the specification rather than in a separate paper, or if the other content requirements \*\*\* are not complied with, the examiner will notify applicant in the next Office action that the information has not been considered. It should be noted, however, that no copy of a U.S. patent application is required to be submitted. \*\*\* Where a U.S. patent application is properly cited, the examiner should obtain access to that file within the Office.

"Examiners must consider all citations submitted in conformance with the rules and this section and place their initials adjacent [sic] the citations on a list or in the boxes provided on a form PTO-1449. If the citations are submitted on a list other than a form PTO-1449, the examiner may write "all considered" and his or her initials to indicate that all citations have been considered. If any of the citations are considered, a copy of the submitted list or form, as reviewed by the examiner, will be returned to the applicant with the next communication. The original copy of the form will be entered into the application file. The copy returned to applicant will serve both as acknowledgement of receipt of the information disclosure statement and as an indication that the references were considered by the examiner. Forms PTO-326 and PTOL-37 include a box to indicate the attachment of form PTO-1449.

"Information which complies with requirements as discussed in this section but which is in a non-English language will be considered in view of the concise explanation submitted \*\*\* and insofar as it is understood on its face, e.g., drawings, chemical formulas, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches. The examiner need not have the information translated unless it appears to be necessary to do so. \*\*\* The examiner should not require that a translation be filed by applicant. The examiner should not make any comment such as that the non-English language information has only been considered to the extent understood, since this fact is inherent.

"Since information is required to be listed in a separate paper rather than in the specification, there is no need to mark "All checked" or "Checked" in the margin of a specification containing citations.

"If a statement fails to comply with the requirements as discussed in this section for an item of information, a line should be drawn through the citation to show that it has not been considered. The other items of information listed that do comply with the rules and this section will be considered by the examiner and will be appropriately initialed.

\* \* \* \* \*

"A citation listed on form PTO-1449 and considered by the examiner in accordance with this section will be printed on the patent. A citation listed in a separate paper, equivalent to but not on form PTO-1449, and considered by the examiner in accordance with this section will be printed on the patent if the list is on a separate sheet which is clearly identified as an information disclosure statement and the list lends itself to easy capture of the necessary information by the Office printing contractor, i.e., each item of information is listed on a single line, the lines are at least double-spaced from each other, the information is uniform in format for each listed item, the list includes a column for the examiner's initials to indicate that the information was considered. If a citation is not printed on the patent but has been considered by the examiner in accordance with this section, the patented file will reflect that fact . . . "

## **Section 6. Copies of Listed Information Items Accompanying This Statement**

**NOTE:** 37 C.F.R. 1.98(a)(2) requires that any information disclosure statement filed under § 1.97 shall include: "A legible copy of: (1) Each U.S. and foreign patent; (ii) Each publication or that portion which caused it to be listed; and (iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included . . . "

**NOTE:** The wording in § 1.98(a)(2)(iii) makes it clear that the requirement to submit a copy of each item of information listed in an information disclosure statement does not apply to the citation of a U.S. patent application. Notice of January 9, 1992, 1135 O.G. 13-25, at 14.

Legible copies of all items listed in Forms PTO/SB/08A and 08B (formerly Form PTO-1449) accompany this information statement.

*(complete the following, if applicable)*

**Exception(s) to above:**

- Items in prior application, from which an earlier filing date is claimed for this application, as identified in Section 4.
- Cumulative patents or publications identified in Section 5.

## Section 7. Concise Explanation of Non-English Language Listed Information Items

**NOTE:** "A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information of each patent, publication, or other information listed that is not in the English language shall be included in any information disclosure statement filed under § 1.97. The concise explanation may be either separate from the specification or incorporated therein." 37 C.F.R. § 1.98(a)(3).

**NOTE:** "[T]he explanation required is limited to the relevance as understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office." Notice of January 9, 1992, 1135 O.G. 13-25 at 14.

**NOTE:** "Where the information listed is not in the English language, but was cited in a search report by a foreign patent officer, the requirement for a concise explanation of relevance is satisfied by submitting an English language version of the search report." Notice of January 9, 1992, 1135 O.G. 13-25, at 14.

**NOTE:** "The concise explanation requirement for non-English language information may be met by submission of an English language version of the search report indicating the degree of relevance found by the foreign office." Notice of January 9, 1992, 1135 O.G. 13-25, at 20.

**WARNING:** "The requirement in § 1.98(a)(3) for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a parent application." Notice of January 9, 1992, 1135 O.G. 13-25 at 20 (emphasis added).

### Swiss 419,526, Biggi, Erberto

According to the translation, Biggi '526 teaches a method of constructing the walls of a building from prefabricated panel units. The panel units are installed side-by-side. The panel units consist of a two panels sandwiching strips placed near the edges of the panels. The panels are attached to each other by means of L-shaped metal tracks at their base, and U-shaped tracks along the tops of the panel units.

The panels share similar structural characteristics to the shear-resisting assembly of the present invention.

### Japan 09 273214 A, Shimzu Construction Co.

This reference appears to teach inserting a designated shear-resisting assembly into a building wall.

### Japan 09 256738 A, J Kenchiku System KK.

This reference appears to teach inserting a designated shear-resisting assembly into a building wall constructed from horizontal top and bottom plates and vertically arranged studs.

### Japan 10 140653 A, Okawa, T.

The panels of this patent appear to share similar structural characteristics to the shear-resisting assembly of the present invention, and appear to be designed to resist lateral loading, although it appears that this is a method for constructing an entire wall out of such panels, rather than inserting such panels into selected portions of the wall built from elongated members.

### Japan 10 184076, NKK Corp

This reference appears to teach inserting a designated shear-resisting assembly into a building made from posts or pillars and beams.

## Section 8. Translation(s) of Non-English Language Documents

NOTE: "If a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in § 1.56(c), a copy of the translation shall accompany the statement." 37 C.F.R. § 1.98(c).

NOTE: "The Office does not intend to require translations unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. Applicants should note, however, that most examiners do not have the ability to understand information which is not in English and that the Office will not routinely translate information submitted in a non-English language. The examiner will consider the information insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, but will not have the information translated unless it appears to be necessary to do so. Applicants are required to aid the examiner by complying with the requirements for a concise explanation in § 1.98(a)(3) for information submitted in a non-English language." Notice of January 9, 1992, 1135 O.G. 13-25, at 21.

NOTE: "The examiner will indicate that the non-English language information has been considered in the same manner as consideration is indicated for information submitted in English." Notice of April 20, 1992 (1138 O.G. 37-41, 41).

- Submitted herewith is an English translation of the following foreign language patents, publications or information or of those portions of those patents, publications or information ~~considered to be material~~ within the control of Applicants' attorney:

Swiss 419,526, Biggi, Erberto, published March 15, 1967 - full translation.

Japan 09 273214 A, Shimzu Construction Co., published October 21, 1997 - Derwent Abstract.

Japan 09 256738 A, J Kgnchiku System KK, published September 30, 1997 - Derwent Abstract.

Japan 10 140653 A, Okawa, T., published May 26, 1998 - Derwent Abstract.

Japan 10 184076 A, NKK Corp., published July 14, 1998 - Derwent Abstract.

No English language translations of the foreign language patents are readily available, except for those listed above.

## **Section 9. Concise Explanation of English Language Listed Information Items (OPTIONAL)**

**NOTE:** "Applicants may, if they wish, provide a concise explanation of why English-language information is being submitted and how it is understood to be relevant. Concise explanations are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability." Notice of April 20, 1992 (1138 O.G. 37-41, 38).

Of the English language patents included in this Information Disclosure Statement, Applicants feel the following are the most important:

390,732  
673,558 — This patent was cited against co-pending application 08/873,972 which also incorporates the boundary edging members of the present application.  
1,604,605  
RE 17,154  
1,622,962  
1,689,642  
1,742,045 — This device can be used as a brace for studs in a wall.  
1,895,667  
2,010,971  
2,193,550  
2,256,394  
2,445,491  
2,633,610  
2,803,856  
3,206,903  
3,310,917  
3,304,675  
3,668,828  
4,122,647 — At column 2, line 44, this patent teaches that the device can be used as a brace for studs.  
4,130,970  
4,648,216  
5,350,265 — This device is used with oversized bolt holes in bottom plates.  
5,375,384 — At column 6, line 1, this patent teaches that the holdown apparatus of the patent can be used with a pre-fabricated shear wall.  
5,467,570 — This patent teaches that screws can be used to attach a holdown at column 3, line 31.  
5,904,025  
CA 2,196,869

Of the printed publications included in this Information Disclosure Statement, Applicants would like to call the examiner's attention to the following:

"The Hardy Frame" Brochure — At page 3, this brochure shows a diaphragm-type shear resisting assembly. Report No. 154 from the American Plywood Association teaches using chords at the ends of the shear wall that rest on the foundation. See page 12.

**Section 10. Identification of Person(s) Making This Information Disclosure Statement**

The person making this statement is

(check each applicable item)

(a)  the inventor(s) who signs below

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**SIGNATURE OF INVENTOR**

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(type name of inventor who is signing)

(b)  an individual associated with the filing and prosecution of this application (37 C.F.R. § 1.56(c))

---

**SIGNATURE OF INVENTOR**

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(type name of inventor who is signing)

(c)  the practitioner who signs below on the basis of the information:

(check each applicable item)

supplied by the inventor(s).  
 supplied by an individual associated with the filing and prosecution of this application. (37 C.F.R. § 1.56(c))  
 in the practitioner's file.

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**SIGNATURE OF PRACTITIONER**

Charles R. Cypher

(type or print name of practitioner)

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405 - 14th Street, Suite 1607

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P.O. Address

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